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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/987,632	11/15/2001	Sumio Nishiyama	Q66942	7412

65565 7590 04/09/2007  
SUGHRUE-265550  
2100 PENNSYLVANIA AVE. NW  
WASHINGTON, DC 20037-3213

EXAMINER
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BENGZON, GREG C

ART UNIT	PAPER NUMBER
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2144

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/09/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

## Office Action Summary

Application No.

09/987,632

Applicant(s)

NISHIYAMA, SUMIO

Examiner

Greg Bengzon

Art Unit

2144

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 January 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

This application has been examined. Claims 1-18 are pending. Claims 13-18 have been submitted as new claims per amendments filed 01/16/2007.

#### ***Making Final***

Applicant's arguments filed 07/12/2006 have been fully considered but they are not persuasive.

The claim amendments regarding -- '*wherein the plurality of data files respectively relate to functions that do not overlap with each other*' -- and the new claims 13-18 do not overcome the disclosure by the prior art as applied in the prior Office Action, as shown below.

The Examiner is maintaining the rejection(s) using the same grounds for rejection and thus making this action FINAL.

#### ***Priority***

This application claims benefits of priority from Foreign Application (Japan) P2000-349470 filed November 16, 2000.

The effective date of the claims described in this application is November 16, 2000.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-18 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claims 1,8,17,18 recites a limitation 'a plurality of data files structured individually by dividing potential distributed data'.

The Applicant Specifications do not indicate or suggest any means for '*dividing potential distributed data*'.

Though the statute does not use the term "undue experimentation," it has been interpreted to require that the claimed invention be enabled so that any person skilled in the art can make and use the invention without undue experimentation. The test of enablement is whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 1,8,17,18 recites a limitation ' a plurality of data files structured individually by dividing potential distributed data'.

The Examiner notes that specification does not contain any written description for '*potential distributed data*'; and that there was no evidence presented by the Applicant of a high level of skill in the art at the time the application was filed.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-18 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1,8,17,18 recites a limitation ' a plurality of data files structured individually by dividing potential distributed data'.

The Examiner notes that the claims recite a limitation for data that has not yet been realized but is only anticipated by the invention, as indicated by the word '*potential*'. The claim language is broad and indefinite as a person of ordinary skill in the networking art is able to ascertain the scope of said limitation.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ashby et al. (EP 0943895) in view of Tagi (US Patent 6473790) further in view of Carroll (US Patent 6421610).

Ashby disclosed (re. Claim 1) a plurality of data files structured individually by dividing distributed data (Ashby Paragraph 53) , wherein each of the data files is classified by type of each data file and is further classified by function (Ashby-Paragraph 74-75) of each data file, and data distribution means for selecting, from among the plurality of data files, only data files that are necessary to constitute the distributed data, (Paragraph 55) combining the selected data files into distributed data, (Ashby-Paragraph 71, 'data in each parcel are logically and/or physically grouped together') and distributing the distributed data.

Ashby disclosed (re. Claim 1) a plurality of data files that respectively relate to functions (Ashby – Figure 5, Paragraph 53, 'each separate subset is tailored specifically for use by one of the functions')

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However Ashby did not explicitly disclose the term distribution server and wherein the plurality of data files do not overlap with each other.

Tagi disclosed a distribution server (Tagi-Column 1 Lines 6-9, Column 2 Lines 57 thru Column 3 Lines 63).

Ashby and Tagi are analogous art because they present concepts and practices regarding the distribution of data to mobile terminal apparatus. At the time of the invention it would have been obvious to a person of ordinary skill in the art to combine Tagi into Ashby. The motivation for said combination would have been to help the user for navigating an unfamiliar building or territory. (Tagi-Column 1 Lines 24-31)

Carroll disclosed generating a nearly seamless mosaiced image covering the entire area of interest, such that the plurality of data files do not overlap with each other. There is neither overlap from one cell to an adjacent cell, nor is there any portion of the entire geospatial image which is omitted when adjacent cells are viewed together. (Carroll-Column 5 Lines 20-25)

Ashby, Tagi, and Carroll are analogous art because they present concepts and practices regarding the distribution of data to mobile terminal apparatus. At the time of the invention it would have been obvious to a person of ordinary skill in the art to



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combine Carroll into Ashby-Tagi. The motivation for said combination would have been to provide seamless transition from one sector to another. (Carroll- Column 3 Lines 35-40)

Ashby-Tagi-Carroll disclosed (re. Claim 2) wherein the data distribution means responds to a formation condition set at a terminal to receive data distribution from said data distribution server and selects data files fitted for the formation condition from among the plurality of data files. (Ashby-Paragraph 55 thru Paragraph 57)

Ashby-Tagi-Carroll disclosed (re. Claim 3) wherein identification codes by function are assigned to the plurality of data files and any desired identification code is specified at the terminal, whereby the formation condition of the distributed data is set. (Ashby-Paragraph 56)

Ashby-Tagi-Carroll disclosed (re. Claim 4) wherein the data files are files of data by function into which data concerning a map is divided by navigation function. (Ashby-Paragraph 55)

Ashby-Tagi-Carroll disclosed (re. Claim 5) wherein a required function for navigation is specified at a navigation system of a terminal to set the formation condition of the distributed data. (Ashby-Paragraph 55)

Ashby-Tagi-Carroll disclosed (re. Claim 6) wherein the data files are files of data by function of at least a display function, a locating function, a search function, and a route calculation function. (Ashby-abstract)

Ashby-Tagi-Carroll disclosed (re. Claim 7) wherein the data files are files of data by function of at least a display function, a locating function, a search function, and a route calculation function. (Ashby-Paragraph 39)

Claims 8-12 are rejected on the same basis as Claims 1-7.

Ashby-Tagi-Carroll disclosed (re. Claim 13) wherein, when an update to the potential distributed data is performed, only a data file or data files, which are necessary to implement the update, are changed. (Carroll-Column 5 Lines 25-30)

Carroll disclosed selecting a portion(s) of geographic information, manipulating said portion(s) separately, and re-integrating said portion(s) (Carroll-Column 6 Lines 35-40). It would be obvious to a person of ordinary skill in the art that by when updating a portion on an individual basis, only that same portion will be required to implement an update.

Claims 14-18 are rejected on the same basis as Claims 1 and 13.

Ashby-Tagi-Carroll disclosed (re. Claim claims 17 and 18) where data files are selected (Carroll-Column 5 Lines 25-30) and that the selected data files are combined into distributed data (Carroll-Column 6 Lines 35-40, Ashby- Paragraph 71, '*data in each parcel are logically and/or physically grouped together*'), in response to a request from a user terminal. (Carroll-Column 5 Lines 25-30)

### ***Response to Arguments***

Applicant's arguments filed 01/16/2007 have been fully considered but they are not persuasive.

As presented in the rejection above, Ashby-Tagi-Carroll disclosed '*wherein the plurality of data files respectively relate to functions that do not overlap with each other*'.

Furthermore, Ashby-Tagi-Carroll disclosed *where data files are selected (Carroll-Column 5 Lines 25-30) and that the selected data files are combined into distributed data (Carroll-Column 6 Lines 35-40), in response to a request from a user terminal*. (Carroll-Column 5 Lines 25-30)

### ***Conclusion***

**Examiner's Note:** Examiner has cited particular columns and line numbers in the references applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

In the case of amending the claimed invention, Applicant is respectfully requested to indicate the portion(s) of the specification which dictate(s) the structure relied on for proper interpretation and also to verify and ascertain the metes and bounds of the claimed invention.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not

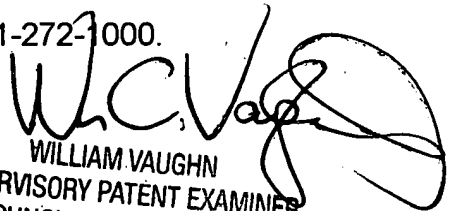
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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Greg Bengzon whose telephone number is (571) 272-3944. The examiner can normally be reached on Mon. thru Fri. 8 AM - 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Vaughn can be reached on (571)272-3922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
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